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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,136	01/27/2004	Walter J. Leclair	WLD-002	1966
959	7590	04/05/2006	EXAMINER	
LAHIVE & COCKFIELD 28 STATE STREET BOSTON, MA 02109			HOFFMAN, MARY C	
			ART UNIT	PAPER NUMBER
			3733	
DATE MAILED: 04/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/766,136

Applicant(s)

LECLAIR, WALTER J.

Examiner

Mary Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/28/06
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 9-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Dudasik (WO 02/34120).

Dudasik discloses a bone fastener having a shaft having a first end and a second end (FIG. 7a-7c+). A screw thread circumnavigates the shaft (page 6, 2<sup>nd</sup> paragraph). A plurality of elongate slots is formed longitudinally in the shaft from the second end, creating a plurality of furcated branches. The plurality of branches is plastically deformed radially outwardly from a first screw diameter to a relatively larger second circumferential diameter. The plurality of furcated branches can compress to the first screw diameter state when the fastener is initially positioned at the opening of a hole. The plurality of furcated branches return to the second circumferential diameter upon reduction of a radially compressive force. The plurality of furcated branches extends for a distance of at least half of the length of the shaft. The screw thread extends from the second end of the shaft at least substantially to the first end of the shaft. A screw head

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is disposed at the first end of the shaft. The fastener comprises a driver recess disposed at the first end of the shaft (see hole in screw head). The plurality of furcated branches has sufficient flexibility. The fastener is formed from titanium.

Claims 1-7 and 9-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Drewry et al. (U.S. Patent No. 6,436,099).

Drewry et al disclose a bone fastener having a shaft having a first end and a second end (FIG. 9E). A screw thread circumnavigates the shaft (ref. #52). A plurality of elongate slots is formed longitudinally in the shaft from the second end, creating a plurality of furcated branches. The plurality of branches is plastically deformed radially outwardly from a first screw diameter to a relatively larger second circumferential diameter. The plurality of furcated branches can compress to the first screw diameter state when the fastener is initially positioned at the opening of a hole. The plurality of furcated branches return to the second circumferential diameter upon reduction of a radially compressive force. The plurality of furcated branches extends for a distance of at least half of the length of the shaft. The screw thread extends from the second end of the shaft at least substantially to the first end of the shaft. A screw head is disposed at the first end of the shaft. The fastener comprises a driver recess disposed at the first end of the shaft (see hole in screw head). The plurality of furcated branches has sufficient flexibility. The fastener is formed from titanium.

With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Enayati which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152

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USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dudasik (WO 02/34120).

Dudasik disclose the claimed invention except for the plurality of furcated branches comprises three branches.

With regard to claim 8, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the plurality of furcated branches of Dudasik comprising three branches, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drewry et al. (U.S. Patent No. 6,436,099).

With regard to claim 8, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the plurality of furcated branches of Drewry et al. comprising three branches, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

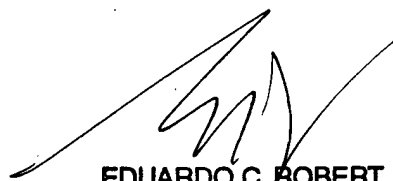
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH

A handwritten signature in black ink, consisting of several loops and a final vertical stroke.A handwritten signature in black ink, featuring a large, sweeping initial 'E' followed by a checkmark-like flourish.

EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER